

### **III. REMARKS**

1. This amendment is being filed in response to the re-opening of prosecution responsive to Applicant's Pre-Appeal Brief Request for Review.

2. Claims 1-8, 11, 12, 17-24, 27, 28, 33-40, 43 and 44 are not unpatentable over the 3<sup>rd</sup> Generation Partnership Project technical specifications (collectively referred to as "3G") under 35 USC §103(a).

The Examiner states that 3G does not explicitly state that the same encryption algorithm is used in the two types of networks. The Examiner then states that it would be obvious to use the same encryption algorithm in the two network types. This position is respectfully traversed.

The 3G references only disclose handover scenarios between UMTS and GSM. The UMTS has its own encryption algorithm while the GSM system has its own algorithm. As a handover occurs from UMTS to GSM, the radio connection changes from a UMTS connection to a GSM connection. The UMTS radio connection provides parameters for the UMTS encryption algorithm while the GSM radio connection provides parameters for the GSM encryption algorithm. It would not be obvious, and there is not any motivation, to use the same encryption algorithm between networks as is claimed by Applicant.

It should also be noted that at the time of filing of the instant application, 1 August 2000, GPRS was only emerging, i.e. the skilled person did not readily consider GSM as a packet-switched TDMA system, but rather a circuit-switched TDMA system. The handover scenarios therefore mainly dealt with

handover of speech connections, i.e. to circuit-switched GSM. Circuit-switched speech was ruling and the present day magnitude of data transfer (web browsing, for example) was non-existent. Text messages were the main data transfer application.

The starting point of the claimed subject matter was different. As packet switched services (GPRS) were defined for the GSM, an encryption algorithm was required. The most natural choice would have been to design a suitable encryption algorithm. To take the encryption algorithm from the UMTS without any modifications required that the parameters for the UMTS encryption algorithm could be obtained with suitable modifications from the already defined GPRS parameters. The claimed subject matter did not start from a handover scenario.

The statement that it would have been obvious to try using the same algorithm or two different algorithms in the two systems is conclusory and speculative. This statement does not reflect the way the skilled person would have encountered and addressed the problem of designing an encryption algorithm for GPRS. There were no limitations for the algorithm, i.e. there were, theoretically, an infinite number of choices. Rejections based on obviousness grounds cannot be sustained by mere conclusory statements. There must be some articulated reasoning with rational underpinning to support the legal conclusion of obviousness. (See *In re Kahn*, 441 F. 3<sup>rd</sup> 977, 988 (CA Fed. 2006).

The problem that is recognized and addressed by Applicant is defined, for example, in paragraph 0008 of the specification. Here it is stated that the structure of the algorithm to be used in GERAN has not been decided. A set of requirements that need to be met is set forth. The Examiner suggests that it would be obvious to use the same encryption algorithm in order to realize the predictable results of reducing overhead as compared to using two different

algorithms. While this may be an added benefit of Applicant's claimed subject matter, it is submitted that it is speculative and does not serve as motivation to combine or modify the references. Obviousness, for purposes of 35 USC §103(a) requires that there be some reason that would have prompted a person of ordinary skill in the art to combine or modify elements. The Examiner sets forth a "benefit", which is only realized by hindsight reasoning. As person addressing the problem solved by Applicant using the required criteria would not have used "overhead" considerations as a motivation to combine or modify references in an effort to achieve Applicant's claimed subject matter.

Thus, one of skill in the art would not have been motivated to use the same encryption algorithm as is recited by Applicant in the claims. It is therefore submitted that a *prima facie* case of obviousness for purposes of 35 USC §103(a) is not and cannot be established. Claims 1-8, 11, 12, 17-24, 27, 28, 33-40, 43 and 44 are not unpatenable over 3G.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Greg Friedman".

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